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| 09/130,998 | 08/07/98 | STERN | M 15818-005000 |
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EXAMINER

TM02/0306

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ART UNIT

PAPER NUMBER

2163

DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/130,998

Applicant(s)

Stern

Examiner

Susanna Meinecke-Diaz

Group Art Unit

2163

☒ Responsive to communication(s) filed on Dec 15, 2000☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-7, 10-14, 21-24, 26, and 27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 1-7, 10-14, 21-24, 26, and 27 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is responsive to the Applicant's amendment filed December 15, 2000.  
Claims 9, 16-20, and 25 have been cancelled.  
Claims 1-7, 10-14, 21-24, 26, and 27 are currently pending.
2. The previously pending 112, 2nd paragraph rejections are withdrawn.  
The previously pending 101 rejection is withdrawn.

### ***Response to Arguments***

3. Applicant's arguments filed December 15, 2000 have been fully considered but they are not persuasive. Applicant's arguments solely address the claim amendments and will therefore be addressed in the art rejection below.

## **ART REJECTION #1**

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-6, 10-13, 21-24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kaplan (U.S. Patent No. 5,963,916).

As per claim 12, it should be noted that a subgroup of products corresponding to a particular date range is inherently associated with a preview history (Fig. 42), a "Top 10" or "Top 20" search (Fig. 8f), a search for "New Releases by Genre" (Fig. 8G), etc.

Since a user at a kiosk, retail store, computer, etc. receives requested music from a network web site (see at least the Abstract), it is inherent that the step of "providing a network management center that receives files from content providers, assigns at least one attribute for each file to create designated files for distribution to end clients and a database containing said designated files" must occur. In response to the user's request, the network web site must have some way of identifying which music to send and where to send it to based on attributes defining said music and a user's particular location. Since the network web site must legally acquire permission from the music producers to release their music, the network web site serves as a network management center which receives music files from the content providers (i.e., the music producers). Furthermore, a user requesting music will only download requested music (i.e., designated files) since it would not be feasible to download all of the music stored at the network web site in the interest of time, bandwidth, and local storage space.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (U.S. Patent No. 5,963,916) as applied to claims 3 and 13 (respectively) above.

Kaplan discloses a web site server which is "able to service a plurality of kiosks across the country or across the world" (col. 9, lines 29-30). Kaplan also discloses the "decompression of audio information to the subscriber" (col. 6, lines 11-12); however, Kaplan fails to explicitly disclose the compression and distribution of its distribution files to its sites via satellite. Official notice is taken that satellite communications are old and well-known in the art. As a matter of fact, satellite communications are commonly used to transmit Internet information "across the world." It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Kaplan's invention to utilize satellite communications to distribute compressed distribution files to its respective sites in order to facilitate quick and efficient global communications.

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**ART REJECTION #2**

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-7, 10-12, 21, 26, and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Doerr et al. (U.S. Patent No. 5,949,411).

Since a user at a kiosk receives requested media from a host (see at least the Abstract), it is inherent that the step of "providing a network management center that receives files from content providers, assigns at least one attribute for each file to create designated files for distribution to end clients and a database containing said designated files" must occur. In response to the user's request, the host must have some way of identifying which music to send and where to send it to based on attributes defining said media and a user's particular location. Since the host must legally acquire permission from the media companies to release their media, the host serves as a network management center which receives media files from the content providers (i.e., the media companies). Furthermore, a user requesting media will only download requested media (i.e., designated files) since it would not be feasible to download all of the media stored at the host in the interest of time, bandwidth, and local storage space.

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***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD  
March 2, 2001

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100